



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,298	02/02/2001	Ira D. Sasowsky	UA372	9202

26360 7590 06/17/2003

RENNER, KENNER, GREIVE, BOBAK, TAYLOR & WEBER
FOURTH FLOOR
FIRST NATIONAL TOWER
AKRON, OH 44308

EXAMINER

BARRY, CHESTER T

ART UNIT	PAPER NUMBER
----------	--------------

1724

DATE MAILED: 06/17/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/776,298

Applicant(s)

SASOWSKY ET AL.

Examiner

Chester T. Barry

Art Unit

1724

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): see attached.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: 10.Claim(s) rejected: 1-5, 7-9, 11.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Chester T. Barry
Primary Examiner
Art Unit: 1724

Applicants' argument that the skilled artisan would have understood Behrends to have meant "or" where he wrote "and/or" is unpersuasive. While the cited extrinsic evidence describes the opinions of some who view with disfavor the use of "and/or," applicants admit that "x and/or y" means x, y, or both x and y. Further, any suggestions that Behrends meant "or" where "and/or" was used is contradicted by Behrends' recognition that mixed media may be used: Note Behrends' description of multiple layers of media at col 1 line 13.¹

Applicants argue Behrends is not enabling of the claimed invention, citing "In re Donahue" [sic, In re Donohue]. From Donohue, please note further that

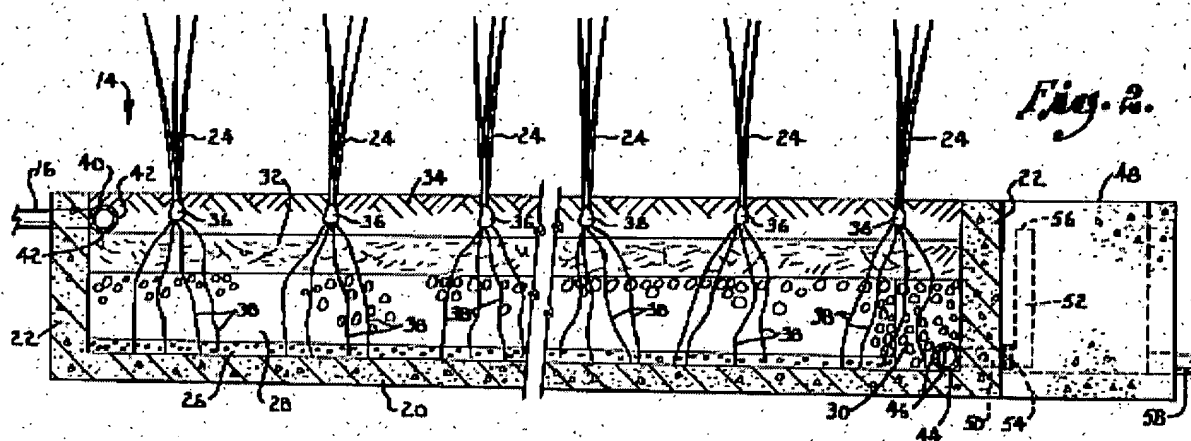
the fact that the author of a pub[li]cation did not attempt to make his disclosed invention does not indicate one way or the other whether the publication would have been enabling.

In re Donohue, 226 USPQ 619 at 621 (Fed. Cir. 1985).

Further, if applicants wish to attack the presumptively enabled disclosure, they should address each ex parte Forman factor: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. *Ex parte Forman*, 230 USPQ 546, 547 (BOPAI 1986).

¹ "[A] layer[or layers] of soil, muck, gravel, or other media . . . " "Layers" of A, B, or C necessarily means at least one layer of A, B, or C next to at least one layer of B or C, A or C, or A or B, respectively, because two contiguous layers of A alone is nothing other than one larger layer of A. So if Behrends' recitation of "layer(s)" means

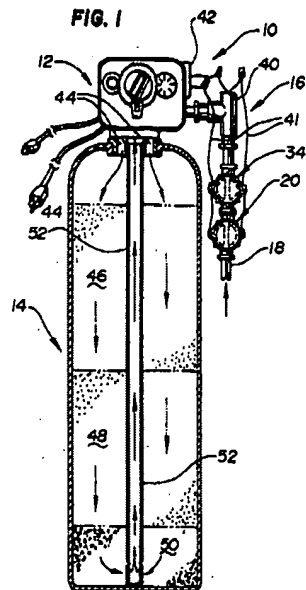
With respect to applicants' assertion that the "general practice" in the art is to use singular substrates, please see Scott's disclosure of gravel layer 28 and crushed limestone layer 30.



Scott

See also Snee's description of "gravel/calcite layer 50" (col 4 line 53) for removing iron from water. See also JP 53-82052's description of heavy metal-laden waste water treated by a solid matter prepared by the addition of lime, cement, and dolomite to illite.

anything at all, it's the recognition that in this art it was known to use different compositions of substrate media in filtration systems.



Snee

The rejection of claim 10 under §112(2nd) is withdrawn in light of the responsive remarks.

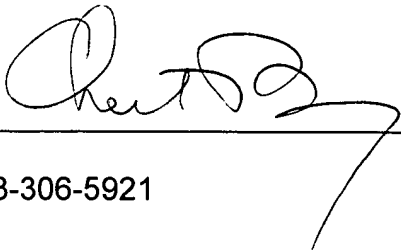
The art rejection(s) of claim 10 is/are withdrawn for want of the prior art to teach or suggest the claimed "alternating ring" arrangement in a pipe.

Claim 10 would be allowed if presented in independent form. In the meantime, it is objected to as being dependent on a rejected base claim.

Applicants discuss various courts' view of the expression "and/or" as an "abominable invention . . . devoid of meaning" or as "a cunning device to conceal rather than express meaning." Applicants submit that "and/or" has the tendency to confuse rather than

Art Unit: 1724

clarify meaning in patent applications. While these points are not persuasive with the examiner on whether Behrends describes the claimed invention, it is noted that assignee's prior patents USP 6528554 and USP 6446031 recite "and/or" in at least claim 8 and claim 9, respectively. To the extent that assignee agrees with applicants' view that "and/or" has the tendency to confuse rather than clarify meaning in patent applications, assignee is advised of 35 USC §251 under which a patent may be reissued to correct an error made without deceptive intent.

A handwritten signature in black ink, appearing to read "Chester T. Barry", is written over a horizontal line. A long, sweeping underline extends from the end of the signature.

703-306-5921

CHESTER T. BARRY
PRIMARY EXAMINER